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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,278	03/25/2004	Naoki Yamane	9683/174	6036

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EXAMINER	
IWUCHUKWU, EMEKA DERRICK	
ART UNIT	**PAPER NUMBER**
2645	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/809,278	YAMANE ET AL.	
	Examiner	Art Unit	
	Emeka D. Iwuchukwu	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/28/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 6/14/2004 and 12/28/2004 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2004/0078752 A1 to Johnson JR *(hereinafter Johnson)*.

With respect to claim 1, Johnson teaches a communication terminal comprising: reception means for receiving data, transmitted from a server, by a first application (paragraph 96); specifying means for specifying a second application on the basis of said data received by said first application (paragraph 50), said second application using said data received by said first application (paragraphs 96-98); writing means for writing in a storage unit, an identifier for indicating said second application specified by said specifying means (paragraph 46), and said

data received by said first application (paragraph 96), said identifier correlating with said data received by said first application (paragraphs 50,96) and; reading means for, when said second application uses said data received by said first application, reading out from said storage unit to provide to said second application, data correlating with an identifier for indicating said second application (paragraphs 50,98).

The second application invokes faxing, printing or beaming (paragraph 50) the data received by the first application (*receiving the e-mail*, paragraph 98), using the identifier stored in the storage unit (paragraphs 50,98).

With respect to claim 4, Johnson teaches the communication terminal according to claim 1, wherein said data is an e-mail (paragraph 96), said first application receives an e-mail from a mail server which distributes the e-mail (paragraph 96), and said second application displays the content of the e-mail (paragraph 97).

With respect to claim 5, Johnson teaches the communication terminal according to claim 4, wherein said writing means writes an identifier correlating with said e-mail in a removable storage unit, the identifier for identifying said second application specified by said specifying means (paragraph 98,107).

With respect to claim 6, Johnson teaches the communication terminal according to claim 4, wherein said first application transmits an e-mail to said mail server (paragraphs 75,83,99), and said writing means writes an e-mail generated by said second application in said storage means (paragraph 99), the e-mail including an identifier for identifying said second application, and said communication terminal further comprises a transmitting means for

transmitting to said mail server, an e-mail read out from said storage unit by using said first application (paragraphs 75,83,99,102).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2&3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson JR *(hereinafter Johnson)* in view of U.S. Patent No. 6,598,076 to Chang et al. *(hereinafter Chang)*.

Johnson teaches the method of Claim 1. Johnson fails to expressly disclose wherein said communication terminal further comprises limiting means for limiting a use of data by said second application, said, data used by said second application correlating with an identifier for indicating said second application in the case that said second application uses said data received by said first application, wherein said second application is an application which is not able to communicate with said server.

In the same field of endeavor, Chang teaches a similar terminal wherein said communication terminal further comprises limiting means for limiting a use of data by said second application, said data used by said second application correlating with an identifier for indicating said second application in the case that said second application uses said data received by said first application, wherein said second application is an application which is not able to communicate with said server (Col 1 Lines 28-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the terminal taught by Johnson to include the limiting means so that the correct application is used to open an attachment to an email e.g. Excel for *.xls documents and not *.pdf documents as taught by Chang (Col 1 Lines 28-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the terminal taught by Johnson to include a second application which is not able to communicate with said server to minimize the computational resource burden placed on the terminal that would occur if every application was in communication with said server.

Claims 7&8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson JR *(hereinafter Johnson)* in view of U.S. Patent Publication 2002/0143885 A1 to Ross JR *(hereinafter Ross)*.

Johnson teaches the communication terminal according to Claim1. Johnson fails to expressly disclose a program for realizing said second application is a program generated by using a Java programming language or the terminal further comprises means for installing a program for realizing said second application by way of the network.

In the same field of endeavor, Ross teaches a similar terminal wherein a program for realizing said second application is a program generated by using a Java programming language (paragraph 125) and the terminal further comprises means for installing a program for realizing said second application by way of the network (paragraph 36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a Java generated program as the second application for versatility.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the means to install a program for realizing said second application by way of the network to increase the terminals capabilities.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0078752 A1 to Johnson JR *(hereinafter Johnson)* in view of U.S. Patent Publication 2003/0110211 A1 to Danon.

Johnson teaches the communication terminal according to Claim1. Johnson fails to expressly disclose the terminal further comprises means for installing a program for realizing said second application by way of the network.

In the same field of endeavor, Danon teaches a similar terminal further comprising means for installing a program for realizing said second application by way of the network (paragraph 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the means to install a program for realizing said second application by way of the network to enhance the terminal's adaptability and increase its playback capability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

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